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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/716,641	11/18/2003	Joseph C. Eder	2024730-7033212001	7680
	7590	12/21/2005	03-168	
Bingham McCuthen, LLP Suite 1800 Three Embarcadero San Francisco, CA 94111-4067			EXAMINER SOOHOO, TONY GLEN	
			ART UNIT	PAPER NUMBER
			1723	
DATE MAILED: 12/21/2005				

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/716,641	Applicant(s) EDER ET AL.	
	Examiner Tony G. Soohoo	Art Unit 1723	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on 12 December 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-48 is/are pending in the application.
- 4a) Of the above claim(s) 2-4 and 10-48 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1 and 5-9 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>5 sheets total</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Election/Restrictions

1. Claims 2-4, 10-48 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected invention and species, there being no allowable generic or linking claim. Election was made **without** traverse in the reply filed on Dec 12, 2005.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

3. Claims 1 and 6 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Solomon 4277184.
4. Claims 1 and 6 are rejected under 35 U.S.C. 102(a) as being clearly anticipated by Mizutani et al 6550957.

5. Claims 1 and 5 are rejected under 35 U.S.C. 102(a) as being clearly anticipated by Bruning 4966468.
6. Claims 1 and 5-9 are rejected under 35 U.S.C. 102(a) as being clearly anticipated by Brüning 4799801. Note disc with perforations 31, and blades 21a1, 21a2, figures 8-9.
7. Claims 1 and 5-9 are rejected under 35 U.S.C. 102(a) as being clearly anticipated by Handler 4676655. Note disc with perforations 128, 139 , and blades 131, figs 8-9.
8. Claims 1 and 5 are rejected under 35 U.S.C. 102(a) as being clearly anticipated by Morrisette 4469153.
9. Claims 1 and 5-9 are rejected under 35 U.S.C. 102(a) as being clearly anticipated by Hutter III 4371094. Note disc with perforations 36, and blades on walls of 34 about the holes 36.
10. Claims 1 and 5-9 are rejected under 35 U.S.C. 102(a) as being clearly anticipated by Cook et al 3475010. Note disc with perforations 54, and blades on walls of between 52 and 50, se figure 2-3, about the holes 36.
11. Claims 1 and 5 are rejected under 35 U.S.C. 102(a) as being clearly anticipated by Krahe et al 3140078. Note disc 62 with perforations.
12. Claims 1 and 5 are rejected under 35 U.S.C. 102(a) as being clearly anticipated by Rossem et al 1998692. Note disc 8 with perforations 12.
13. Claims 1 and 5 are rejected under 35 U.S.C. 102(a) as being clearly anticipated by Frei et al US 2005/0111299. Note disc with perforations 19.

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14. Claims 1 and 5-9 are rejected under 35 U.S.C. 102(a) as being clearly anticipated by Hicks 2825134. Note disc with perforations 53, figure 7, and blades 51, 52, or the blades 24, figure 1, and piston 26.

15. Claims 1 and 5 are rejected under 35 U.S.C. 102(a) as being clearly anticipated by Lund 5273190. Note disc with perforations 88.

Conclusion


16. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Trautmann 3164303, Hoag et al 6120174, Rodgers et al 6293693, Morris et al 6488651, Frei et al 6974247, Mizutani et al 6367962, Cook et al 3475010, Coates 3195778, Fairbanks 1458282, Trumbull 3188057, Morrison 1954143.

17. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Tony G. Soohoo whose telephone number is (571) 272 1147. The examiner can normally be reached on 7-5PM, Tue-Fri.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Wanda Walker can be reached on 571-272-1151. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Tony G Soohoo
Primary Examiner
Art Unit 1723
